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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,045	10/31/2000	Louis J. Morsberger	MFSI-001/01US	8530
22903	7590	12/18/2003	EXAMINER	
COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			ROBINSON BOYCE, AKIBA K	
		ART UNIT	PAPER NUMBER	
		3623		
DATE MAILED: 12/18/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N.	Applicant(s)
	09/702,045	MORSBERGER, LOUIS J.
	Examiner	Art Unit
	Akiba K Robinson-Boyce	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 October 2000.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-20 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. ____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,6,7. 6) Other: _____

DETAILED ACTION

Status of Claims

1. Due to communications filed 10/3/00, the following is a non-final first office action. Claims 1-20 are pending in this application and have been examined on the merits. Claims 1-20 have been rejected as follows.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1- 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of :

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful art" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 is directed to a method for collecting survey information relative to a transaction. Claim 1 recites the steps of “receiving transaction information related to a transaction, the transaction information including consumer information and merchant information”, “comparing the consumer information with predetermined consumer information”, “comparing the merchant information with predetermined merchant information”, “determining whether to invite the consumer to complete a survey related to the transaction”. These steps represent mere ideas in the abstract since they do not recite any computer technology or physical means to help carry out the process. Since no computer technology nor physical means are disclosed, claim 1 and all claims that depend from it (Claims 2-9) are therefore found to be non-statutory.

In the present case, claim 10 is directed to a method for collecting survey information relative to a transaction. Claim 10 recites the steps of “inviting consumers to participate in a survey program”, “receiving consumer information from participating consumers”, “developing historical consumer information for each of the participating consumers”, “receiving transaction information related to a transaction, the transaction information including information relating to the consumer in the transaction”, “determining, using the information relating to the consumer in the transaction, whether the consumer in the transaction is a participating consumer”, “determining, using historical consumer information, whether to collect survey information from the consumer in the transaction”. These steps represent mere ideas in the abstract since they do not recite any computer technology or physical means to help carry out the

process. Since no computer technology nor physical means are disclosed, claim 10 and all claims that depend from it (Claims 11-15) are therefore found to be non-statutory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-10 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US 6,260,024), and further in view of Pinsley et al (US 6,070,145).

As per claim 1, Shkedy discloses:

receiving transaction information related to a transaction, the transaction information including consumer information and merchant information, (Col. 5, lines 13-15, lines 28-30, [buyer identification, specification of item, quantity represents transaction data, seller bidding date represents merchant information], Col. 6, lines 8-10, [sellers identifying PPOs relevant to their products also represents seller information]);

comparing the consumer information with predetermined consumer information, (Col. 5, lines 61-63, [authenticating against the buyer database]);

comparing the merchant information with predetermined merchant information, (Col. 6, lines 22-23, authenticating the identification of a seller], (Col. 30, lines 1-3, [comparing with seller identification database];

Shkedy fails to disclose the following, however Pinsley et al discloses:

determining whether to invite the consumer to complete a survey related to the transaction, (Col. 4, lines 9-11, [where the offer is made based on the conclusion of a transaction]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine whether to invite the consumer to complete a survey related to the transaction with the motivation of collecting the owner's views in order to get a better idea of how to improve the processing of the transaction.

As per claim 2, Shkedy discloses:

wherein the consumer information includes a consumer identification code, and the predetermined consumer information includes information relating to consumers defined as prospective offerees, (Col. 5, lines 13-15, [buyer identification], w/ Col. 7, lines 26-32, [pre-negotiated seller contract with prospective buyers]).

As per claim 3, Shkedy discloses:

wherein the predetermined merchant information includes information relating to categories of purchases, and wherein determining whether to invite the consumer to complete a survey includes determining whether the transaction corresponds to one of said categories of purchases, (Col. 7, lines 33-42, [pre-negotiates a contract, collective buyer pool]).

As per claim 4, Shkedy discloses:

wherein determining whether the transaction corresponds to one of said categories of purchases includes determining whether there is an unsatisfied quota of survey invitations for the particular type of transaction, (Ab, lines 12-14, [resolve disputes]).

As per claim 5, Shkedy fails to disclose the following, however Pinsley et al discloses:

wherein determining whether to invite the consumer to complete a survey includes determining whether the transaction meets predetermined criteria and is a qualifying transaction, (Col. 4, lines 8-11, [conclusion of transaction]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine whether to invite the consumer to complete a survey including determining whether the transaction meets predetermined criteria and is a qualifying transaction with the motivation of filtering out all of the consumers whose transaction does not correspond with the questions of the survey.

As per claim 6, Shkedy fails to disclose the following, however Pinsley et al discloses:

transmitting to the consumer an invitation to complete a survey relating to the qualifying transaction, (Col. 4, lines 48-49, [transmitting]);

receiving survey information from the consumer relating to the qualifying transaction, (Col. 3, lines 5-6, [information collected]); and processing the received survey information, (Col. 3, line 62, [processed]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit a survey, receive the survey information and process the received survey information with the motivation of obtaining relevant feedback information about a customer's transaction.

As per claim 7, Shkedy discloses:

wherein the predetermined consumer information is provided by a party to the transaction other than the merchant, (Col. 1, lines 8-12, [intermediary]).

As per claim 8, Shkedy fails to disclose the following, however Pinsley et al discloses:

offering processed survey information to a merchant; and granting access to the processed survey information to the merchant, (Col. 3, line 6, [information delivered to advertiser where the advertiser represents the merchant]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to offer and grant access to the processed survey information to the merchant with the motivation of allowing the merchant to access customer information about the transaction that will help with the improvement of future transactions.

As per claim 9, Shkedy discloses:

wherein the transaction information includes a transaction record, the transaction record being in at least one of an electronic form and a digital form, and receiving transaction information includes receiving a set of transaction information regarding several transactions, (Col. 13, lines 7-8, [FPO represents the record], Col. 13, lines 31-

34, [electronic contract], w/ Ab, lines 7-12, [facilitating transactions by aggregating offers]).

As per claim 10, Shkedy discloses:

receiving consumer information from participating consumers, (Col. 5, lines 13-15, [buyer identification]);

developing historical consumer information for each of the participating consumers, (Col. 10, lines 1-7, [credit history]);

receiving transaction information relating to a transaction, the transaction information including information relating to the consumer in the transaction, (Col. 5, lines 13-15, [buyer identification]);

determining, using the information relating to the consumer in the transaction, whether the consumer in the transaction is a participating consumer, (Col. 5, lines 13-15, [buyer items]); and

determining, using the historical consumer information, (Col. 10, lines 1-7, [credit history of transactions],

Shkedy fails to disclosed the following, however Pinsley et al discloses:

inviting consumers to participate in a survey program, (Col. 4, lines 44-45, [offering]);

determining...whether to collect survey information from the consumer in the transaction, (Col. 4, lines 9-11, [offer to participate is made at the conclusion of a transaction based on pre-determined criteria]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to invite consumers to participate in a survey program and to determine whether to collect survey information from the consumer in the transaction with the motivation of determining if the consumer would be worth keeping and performing transactions with.

As per claim 12, Shkedy discloses:

wherein the transaction information includes at least one of the category of the transaction and the payment amount of the transaction, and determining whether to solicit survey information from the consumer in the transaction includes using at least one of the category of the transaction and the payment amount of the transaction, (Col. 5, lines 10-11, [category included in FPO], w/ Col. 5, line 67-Col. 6, line 3, [authenticating and adding to FPO]).

As per claim 13, Shkedy fails to disclosed the following, however Pinsley et al discloses:

wherein soliciting survey information includes transmitting a survey invitation to the consumer to the transaction, (Col. 4, lines 41-45, [transmitting/offering]), and the survey invitation includes instructions regarding the survey, (Ab, lines 3-5, [instructions into an information document]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit the survey invitation to the consumer and to include instructions with the motivation of allowing the consumer to have accessibility to a survey that can be easily interpreted.

As per claim 14, Shkedy fails to disclose the following, however Pinsley et al discloses:

wherein the survey invitation includes a survey instrument, (Col. 6, line 31, [survey document]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the survey invitation to include a survey instrument with the motivation of providing something tangible which would assist a user in documented answers to survey questions.

As per claim 15, Shkedy discloses:

wherein the transaction information includes a transaction record, the transaction record being in at least one of an electronic form and a digital form, and receiving transaction information includes receiving a set of transaction information regarding several transactions, (Col. 13, lines 7-8, [FPO represents the record], Col. 13, lines 31-34, [electronic contract], w/ Ab, lines 7-12, [facilitating transactions by aggregating offers]).

As per claim 16, Shkedy discloses:

a monitoring interface processing transaction information from the transaction, (Col. 13, lines 8-9, [central controller {200}]), the transaction information including a transaction record with information relating to the consumer to the transaction, Col. 13, lines 7-8, [FPO represents the record], the transaction record being in at least one of an electronic form and a digital form, Col. 13, lines 31-34, [electronic contract];

a processor analyzing said transaction record relative to stored consumer information, (Col. 12, line 2, [processing device]); and

a participant interface enabling the consumer to the transaction to provide...information, (Col. 13, line 10, [buyer interface]);

the processor determining whether the consumer to the transaction is a participant in a survey and determining whether to solicit survey information from the consumer to the transaction/provide survey information, (Col. 4, lines 8-11, [offer to participate based on selection criteria]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine whether the consumer to the transaction is a participant in a survey and determining whether to solicit survey information from the consumer to the transaction with the motivation of determining if the consumer would be worth keeping and performing transactions with.

As per claim 17, Shkedy discloses:

wherein the transaction record includes information relating to at least one of the category of the transaction and a payment amount of the transaction, and said processor determines whether to solicit survey information based on at least one of the category of the transaction and the payment amount of the transaction, (Col. 5, lines 10-11, [category included in FPO], w/ Col. 5, line 67-Col. 6, line 3, [authenticating and adding to FPO]).

As per claim 18, Shkedy discloses:

wherein the information relating to the consumer to the transaction includes an identification code for the consumer to the transaction, (Col. 5, lines 13-15, [buyer identification]), and the processor compares identification codes of consumers to transactions with predetermined identification codes of participants in the survey, (Col. 5, lines 61-63, [authenticating buyer identification number against a buyer database]).

As per claim 19, Shkedy discloses:

a merchant interface enabling a merchant to access analyzed survey information, (Col. 11, line 22, [seller interface {300}]).

As per claim 20, Shkedy discloses:

wherein the stored consumer information is provided by a party to a transaction other than the merchant, (Col. 1, lines 8-12, [intermediary]).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US 6,260,024), and further in view of Pinsley et al (US 6,070,145), and further in view of Kurland et al (US 4,603,232).

As per claim 11, Shkedy discloses:

wherein the information relating to the consumer in the transaction includes a consumer identification code, (Col. 5, lines 13-15, [buyer identification])

Both Shkedy and Pinsley et al fail to disclose, however Kurland et al discloses: and the historical consumer information includes at least one of the number of invitations sent to the consumer and the number of surveys completed by the consumer, (Col. 7, lines 24-37, [mail-out-count/quota]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to keep track of the number of invitations sent to the consumer and the number of surveys completed by the consumer with the motivation of determining the customers that need more attention.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


A. R. B.
December 11, 2003


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
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